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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,840	12/21/2001	Lisa Baker	PGI6044P0780US	4948
32116	7590	03/31/2006	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			STEPHENS, JACQUELINE F	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,840

Applicant(s)

BAKER, LISA

Examiner

Jacqueline F. Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 1/21/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "a uniform admixture".

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

2. Applicant's arguments filed 1/21/05 have been fully considered but they are not persuasive. Applicant argues the claim language clearly structurally differentiates applicant's claimed article from the cited Nakamura reference, in that Nakamura does not disclose a uniform admixture of a hydroxydiphenyl ether and an aliphatic acid carrier. However, the limitation "uniform admixture" is not supported by the original specification.

Applicant argues the odor control compound is present as a coating at the surface of the associated base substrate material by having been topically applied in aqueous form. The examiner again points to the Nakamura reference, page 18, lines 1-18, which discloses a substrate with the compound attached to the substrate, or alternatively the compound enveloped by the substrate, or further, the compound

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distributed between two tissue webs. In at least the instance of the compound attached to the surface, some portion of the surface is coated with the compound. As to the aqueous topical application of the compound, the compound of Nakamura attached to the substrate results in a topical application. How the compound is applied does not patentability distinguish the *structure* over the prior art. There is no evidence and/or comparison of any unexpected result in terms of the topical application in aqueous form compared to the attached compound disclosed in the prior art. The rejection has been made in the sense of *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted), which states that when the product is claimed the patentability is defined only by the product per se, not by the process of its making and the burden is shifted to Applicant to show that the process of the prior art produces a different product. This should be presented by the factual evidence, and in the instant case the Applicant failed to show a valid side-by-side comparison between their product and the product disclosed by the Nakamura reference wherein the only difference is the process of their making as per *In re Dunn*, 349 F. 2d 433, 146 USPQ 489 (CCPA 1965).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 3, 4, 7, 8, and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by Nakamura WO 99/38541.

As to claims 1, 7, 8, and 11, Nakamura discloses an odor control absorbent article comprising:

a) a base substrate material selected from the group consisting of nonwoven fabrics, woven fabrics, polymeric films, and the combinations thereof (page 22, lines 3-17);

b) an odor control compound;

c) the odor control compound comprising an admixture of a hydroxydiphenyl ether and aliphatic acid (page 6, lines 29-32, page 8, lines 18-26) carrier;

d) Nakamura discloses a substrate with the compound attached to the substrate, in which case the compound is present as a coating on at least a portion of the substrate to which it is attached (page 18, lines 1-18). The limitation the odor control present as a coating by applying the compound topically to the base substrate material is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product

was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

e) with the base substrate material formed into a component material for a disposable sanitary product, (page 1, line 15-17, page 6, lines 29-32; page 8, lines 18-26; page 14, lines 28-34; page 18, lines 1-18; page 20, lines 7-20, and Figure 1). Regarding the limitation of the aliphatic acid carrier acting to shift the pH of the hydroxydiphenyl ether environment, and the examiner’s interpretation of the performance characteristics of the instant apparatus claims, when the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980). In the present case, the reference has met the structural requirements of claim by providing a base substrate with an attached compound comprising an admixture of a hydroxydiphenyl ether and an aliphatic acid carrier.

As to claim 3, Nakamura discloses the hydroxydiphenyl ether is a trichlorodiphenyl ether (page 14, lines 28-34).

As to claim 4, Nakamura discloses the modified acidic carrier is an organic acid (page 6, lines 29-32, page 8, lines 18-26).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura. Nakamura discloses the present invention substantially as claimed. However, Nakamura does not specifically disclose the odor control absorbent article is a training pant or a pull-on garment. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the odor control absorbent article to include a training pant or pull-on garment as it is old and well known in the art that disposable hygiene products can include diapers, sanitary napkins, training pants, pull-on garments, and incontinence garments.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Beall et al. USPN 6287634. Nakamura discloses the present invention

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substantially as claimed. However, Nakamura does not disclose the aliphatic acid is a hexanedioic acid. Beall discloses the use of hexanedioic acid in a topical treatment compound (col. 12, lines 20-21 and col. 22, lines 53 through col. 23, line 16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate hexanedioic acid in the invention of Nakamura as taught in Beall. Doing so would provide a compound that can be combined with a topically- active compound and homogeneously dispersed as an insoluble, particulate material in order to deliver a topical treatment, to be delivered to the skin, which Beall teaches is desired (col. 22, lines 53-67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Primary Examiner
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March 8, 2006